UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/576,546	05/22/00	LEZER N	05725.0588-0

HM12/0223
FINNEGAN HENDERSON FARABOW GARRETT & DUN
1300 I STREET NW
WASHINGTON DC 20005-3315

EXAMINER	
TRAN, S	
ART UNIT	**PAPER NUMBER**
1615	7

DATE MAILED: 02/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/576,546	Applicant(s) Lezer
	Examiner Susan Tran	Group Art Unit 1615

☒ Responsive to communication(s) filed on *Dec 21, 2000*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-32* is/are pending in the application.

Of the above, claim(s) *8-13* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-7 and 14-32* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *6*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Receipt is acknowledged of applicants Declaration and Fee filed 09/22/00, Information Disclosure Statement filed 05/22/00, and Response to Election filed 12/21/00.

Election/Restriction

1. Applicant's election with traverse of polyamide fibers, claims 1-7, 14-32 invention in Paper No.6 is acknowledged.

Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

2. Applicant's arguments filed 12/21/00 have been fully considered but they are not persuasive.

There are two criteria for a proper requirement for restriction between patentable distinct inventions:

1. The inventions must be distinct as claimed (see MPEP && 806.05-806.05(I)); and

2. There must be a serious burden on the examiner if restriction is not required (see MPEP && 803.02, 806.04(a)-(j), 808.01(a) and 808.02(a).

A serious burden on the examiner is shown according to the criteria of MPEP&808.02, where one of the following must be supported by appropriate explanation:

1. Separate classification thereof;

Applicants agree that the restriction requirement is proper set forth in MPEP§803.01 when there is a serious burden on the Examiner, by showing separate classification, separate status in the art, or different field of search. There are different and burdensome fields of search:

Cellulose fiber (8/532);

Acetate fiber (252/8.86);

Acrylic fiber (442/167);

Polyolefin fiber (8/928);

Carbon fiber (65/42);

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 7, 15-17, 23, 24, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 7, 15-17, 23, 24, and 28 are indefinite in the use of the phrase "chosen from". If Markush language is intended, the appropriate phrasing is "selection from the group consisting of". Correction is requested.

Claim 7 contains the trademark/trade name "TEFLON®". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe fibers and, accordingly, the identification/description is indefinite.

Claim 28 is indefinite in the use of the phrase "and cosmetic and dermatological active agents." If Markush language is intended, it is suggested to eliminate the term "and" before the phrase "cosmetic and dermatological active agents".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7, 15-18, 20, 23, 24, and 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Arraudeau et al. USPN 4,659,562 ('562).

Arraudeau teaches an anhydrous cosmetic composition comprising fiber having length greater than it's diameter (column 1, lines 11-62), propylene glycol dicaprylate, glycerol, and oils (column 2, lines 40 through column 3, lines 1-9; and examples 1, 2, 7, 8, 12, 13). The cosmetic composition does not require consequently, new or repeated applications (column 1, lines 32-36).

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1, 4-7, 14-18, 20, 23, 24, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Franzke et al. USPN 5,965,146 ('146).

Franzke teaches a cosmetic composition comprising polyamide fiber having diameter of 8 to 70 μm, length between 20 to 2000 μm (column 1, lines 56 through column 2, lines 1-67; and example 18). The composition further comprising glycols, silicone oil, and polymers (column 3, lines 1-36).

The examiner notes that the cited references are silent as to the teaching of the L/D value. However, it is the position of the examiner that no criticality is seen in the use of the particular value since the prior arts obtain the same results desired by applicant, i.e. an anhydrous cosmetic composition useful for skin and lips. The particular L/D value has not been shown to provide any unusual and/or unexpected results over the applied prior arts.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 14-22, and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al. ('562), in view of Bara et al. USPN 6,177,091 B1 and Arnaud FR 2786393A1 (Abstract).

Arraudeau is relied upon for the reasons stated above. The reference differs from applicants claimed invention by not specifically teaching the IOB value and the parleam oil.

Bara teaches an anhydrous cosmetic composition comprising oils, fiber (column 1, lines 50 through column 2, lines 1-16; and column 5, lines 25 through column 6, lines 1-45), and parleam oil (column 3, lines 1-33).

Arnaud teaches an anhydrous cosmetic composition comprising liquid polyol in a lipid phase having IOB value of 1-7. Thus, it would have been obvious for one of the ordinary skill in the art to modify Arraudeau's cosmetic composition using parleam oil in view of the teaching of Bara, and liquid polyol in view of the teaching of Arnaud. The reason for this modification is to obtain a homogeneous anhydrous cosmetic composition that prevents unaesthetic folds, migration of the makeup, and thus provides long lasting property on skin or lips.

With regard to the length and the diameter of the fiber, it is the position of the examiner that it would have been obvious for one of the ordinary skill in this art to, by routine experimentation determine suitable length and diameter of the fiber to obtain a desire anhydrous cosmetic composition that will provide long lasting appearance, and thus will not require repeated applications.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shukuzaki et al., Atlas, and Evison et al. are cited as being of interest for teaching anhydrous cosmetic composition comprising fiber.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600